

**Remarks**

Applicants request amendment of the claims to reflect the proposed election.

Applicants have not withdrawn the method of use claims, to facilitate potential rejoinder of the process commensurate in scope with allowable compound claims.

Applicants first wish to point out that the present application is a PCT application originating from the United States, in accordance with 35 USC 371 (a). Thus, 35 USC 372 (a) is applicable to the National Phase examination of the application and consideration regarding the findings from the PCT search and examination is proper.

Applicants maintain that the exemplary groups set forth in the Examiner's present restriction requirement are neither an appropriate restriction of the present invention nor in compliance with the requirement of MPEP 814, wherein the restriction requirement must provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions so that it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement and therefore subject to the prohibition against double patenting rejections under 35 USC 121.

If a compound genus is allowable, then the disease states implicated by the mechanism of action should likewise be allowable for compounds commensurate in scope with the allowed compound claims. To further clarify, the retained method of use claims are each directed to a use of the compounds for treating a condition implicated with the modulation of a PPAR. Applicants request that Examiner Young consider including the composition and use of products commensurate in scope with compounds of the elected genus. Alternatively, Applicants request rejoinder of the subject matter of these claims, commensurate in scope with compounds of the elected genus, when allowable claim scope is determined. According to M.P.E.P. §821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with

process claims (or process for using in this instance) commensurate in scope with the allowed product claims is permitted following a finding that the product claims are allowable.

Applicants respectfully request clarification that any subject matter not set forth in the exemplary Restriction Requirement grouping be designated as Group VI to ensure that such subject matter may properly be claimed in a subsequent divisional application. Applicants maintain that exemplary groupings that do not clearly define the invention disclosed, and inappropriately expose Applicants to a potential Double Patenting rejection when Applicants attempt to claim subject matter contained in none of the exemplary Groupings of this application. Further, under the new rules regarding continuation practice, the exemplary groupings will improperly preclude the Applicant from protecting the full scope of the present invention, by denying the applicant the ability to file a proper divisional application for disclosed, but non-elected inventions.

If the Examiner does not find Applicants remarks persuasive and decides maintain the present V way exemplary restriction, Applicants respectfully request that method of use claims, commensurate in scope with an allowable compound claim, be rejoined when a product claim is found to be allowable. According to M.P.E.P. §821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims is permitted following a finding that the product claims are allowable.

### **Conclusion**

Applicants hereby elect the genus embracing the compound of Example 9(a), with traverse, as explained herein. Applicants request reconsideration regarding the grouping of the invention to both to comply with MPEP 814, and PCT 13.1. Alternatively, if the restriction to exemplary Groups is maintained, Applicants request consideration for rejoinder of the specific methods of use, each associated with PPAR modulation commensurate with the allowable compound scope. Further, Applicants strongly request that the Examiner issue a proper final restriction requirement to enable the filing of compliant divisional applications claiming subject matter that is not elected in this application. In particular, Applicants are concerned that an

Exemplary Grouping be recognized as a proper group for future election (so that no continuation would be required), and that subject matter not embraced in any groupings may be properly elected in future divisional application. Applicants hereby reserve the right to claim any non-elected subject matter in one or more divisional applications.

Applicants respectfully request entry of the amendments to the Claims to reflect the present election in response to the restriction requirement, prior to any action on the merits.

Applicants respectfully request consideration of Applicants' comments regarding the PCT unity of invention finding.

Examiner Young is respectfully requested to contact the undersigned attorney on any matter related to this application.

Respectfully submitted,

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